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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/855,281	05/15/2001	Takenori Kohda	JP920000095	1913

7590 05/25/2006

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EXAMINER
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BATURAY, ALICIA

ART UNIT	PAPER NUMBER
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2155

DATE MAILED: 05/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

09/855,281

Applicant(s)

KOHDA ET AL.

Examiner

Alicia Baturay

Art Unit

2155

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 15 May 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: NONE.

Claim(s) objected to: NONE.

Claim(s) rejected: 1-22.

Claim(s) withdrawn from consideration: NONE.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

  
SALEH NAJJAR

SUPERVISORY PATENT EXAMINER

Continuation of 11. does NOT place the application in condition for allowance because:

Applicant Argues: "Thus, Applicants believe that claims 16 and 17 contain statutory subject matter under § 101 and therefore request withdrawal of the rejections under § 101."

In Response: Applicant's system of claims 16 and 17 is still believed to have been reasonably interpreted by one of ordinary skill as directed to a software object and software means for managing that object. While Applicant's representative has continued to argue that the claim is not directed to software, per se, Applicant's representative has likewise continued to fail to point to any element of claim 16 which is necessarily limited to hardware or other physical article or object which enables the software to act as a computer component and realize the functionality of the claimed software.

Applicant's representative has also continued to argue that even if the claim is directed to software, per se, that software, per se, is statutory. Contrary to Applicant's representative's assertion, the examiner is not aware of, nor is it believed correct to conclude, the State Street decision in any way suggested, implied or otherwise indicated in any way that software (functional descriptive material), per se, is statutory. In fact, Applicant's representative's continuing to argue that software, per se, is patent-eligible subject matter is believed to be without precedent in any case law and directly contrary to the existing case law (at least Warmerdam). To the best of the examiner's knowledge and belief, for software to be statutory, it must be claimed in combination with the necessary physical article or object which allows it to act as a computer component and realize its functionality. Further, the software must be in executable format and, when executed, cause the computer to perform a practical application, either through causing a physical transformation or a useful, concrete and tangible result.

Applicant Argues: "There is no evidence in Kay of object movement nor is there evidence that any such object movement advertises a product or service to a potential customer. Further, there is no evidence in Miles that such movement would be useful in the scavenger hunt advertising scheme."

In Response: Applicant's representative presents many similar arguments as those submitted before the latest final rejection and which the Office Action dated 14 March 2006 addresses. Examiner maintains her position with respect to these arguments, the response to which can be found in the final office action dated 14 March 2006.

Additionally, the examiner respectfully submits that Kay teaches object movement (the button icon may be implanted or overlayed on the web page at a single location, or at a plurality of locations. When activated, the button icon will send the customer via a link to a separate page or window where an order form will be provided on which the customer indicates or confirms the product or service to be ordered - see Kay, page 4, lines 22-27) that advertises a product or service to a potential customer (These and other objectives are obtained by the present invention which contemplates a method for promoting purchases from an Internet web site. The methods include the step of advertising a product or service information on at least one merchant web page accessible to a potential customer through a web browser over a network line. The method includes the further step of overlaying on the web page, a button icon which is adapted to be activated by the customer when the customer desires to purchase a product or service - see Kay, page 3, line 23 - page 4, line 2).

Also, the examiner respectfully submits that Miles, in analogous art, teaches a similar method of driving customers to view advertisers' websites ("In this new advertising model, the hosting site sponsors a treasure or scavenger hunt in which participants are asked to provide answers to questions. The intent of the hosting site operators is to direct participants to advertiser Web sites in order to locate answers to those questions" - see Miles, col. 2, lines 5-10; and "The present invention relates to a method and apparatus for stimulating or encouraging a potential customer viewing a web site on the Internet to purchase goods or services on the web site" - see Kay, page 1, lines 7-10). In addressing the argument that Miles does not teach that the movement in Kay would be useful in a scavenger hunt advertising scheme, the examiner submits that Miles teaches users clicking on a link displayed on the page of an advertiser which takes the user to the game site (see Miles, col. 10, lines 45-49). The button icon described in Kay that may be implanted or overlayed on the web page could be substituted for Miles' link that returns the user to the game site ("by clicking on a...hyperlink on that page of that...site...the participant is returned to the game site" - see Miles, col. 10, lines 45-49). In this way, Kay's button icon appears at the end of an answer/clue set for users to find on the advertiser's sites, in much the same way that Miles' hyperlink that appears on a page of a site functions now. Thus, the movement of Kay's button icon from one web page location to another (the button icon may be implanted or overlayed on the web page at a single location, or at a plurality of locations - see Kay, page 4, lines 22-27), functions as an icon the user moving through the answer/clue set always looks for when attempting to solve each answer/clue set making up the scavenger hunt.